UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,252	04/10/2006	Thomas D. Fountian	36321-8024.US01	6467

22918 7590 07/11/2008

PERKINS COIE LLP
P.O. BOX 1208
SEATTLE, WA 98111-1208

EXAMINER	
SU, SARAH	
ART UNIT	**PAPER NUMBER**
2131	
MAIL DATE	**DELIVERY MODE**
07/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/526,252	FOUNTIAN, THOMAS D.	
	Examiner	Art Unit	
	Sarah Su	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-56* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-56* is/are rejected.

7)☒ Claim(s) *1,2,8,19,22,27,39,42,44,46,53,54 and 56* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 February 2005* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/24/05, 1/17/06, 8/8/06, 3/31/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Preliminary Amendment, received on 24 February 2005, has been entered into record.

2. Claims 1-56 are presented for examination.

Priority

3. The claim for priority from PCT/US03/26637 filed on 25 August 2003 and the US Provisional Application 60/405,848 filed on 24 August 2002 is duly noted.

Specification

4. The disclosure is objected to because of the following informalities:

a. in page 2, line 6 (of amendment submitted 24 February 2005): "by referenced in their" should read –by reference in their–.

Appropriate correction is required.

Claim Objections

5. Claims 1-2, 8, 19, 22, 27, 39, 42, 44, 46, 53-54 and 56 are objected to because of the following informalities:

a. Claims 1, 19, 42, 46, 53-54 and 56 set forth a plurality of elements or steps, but each element or step is not separated by a line indention. See 37 CFR 1.75(i).

b. In claim 2, line 2: "a user computer" is unclear if it relates to "a user computer" (claim 1, line 1);

c. In claim 8, line 2: "the software vendor" lacks antecedent basis;

d. In claim 19, line 3: "a user computer" is unclear if it relates to "a user computer" (claim 19, line 2);

e. In claim 22, line 2: "the user" and "the software vendor" lack antecedent basis;

f. In claim 27, line 1: "a feature" is unclear if it relates to "a feature" (claim 19, line 1);

g. In claim 39, line 2: "through a through an Internet" should read –through an Internet–;

h. In claim 44, line 2: "a user" is unclear if it relates to "a user" (claim 42, line 3);

i. In claim 54, line 3: "the user computer" lacks antecedent basis.

Appropriate correction is required.

Drawings

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because:

a. reference characters "60" and "55" have both been used to designate "full software package" (page 7, lines 15-17);

b. reference character "60" has been used to designate both "full software package" (page 7, lines 15-16) and "software products" (page 7, line 27);

c. reference character "80" has been used to designate both "a software package" (page 7, line 30) and "system interface" (page 7, line 31).

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because:

a. they include the following reference character(s) not mentioned in the description: 391 (Figure 7);

b. they do not include the following reference sign(s) mentioned in the description: 470, 460A, 460B, 460C, 460D, 480, 490 (page 12, lines 13-19).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 53-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are non-statutory for at least the reason that they are not tangibly embodied in a manner so as to be executable (i.e. stored on a computer readable medium, specifically not including a carrier wave or other transmission medium). Further, the data structures of claims 53-54 and the software package of claim 55 are non-functional descriptive material since no requisite functionality is present to satisfy the practical application requirement; thus, the data structures and software package may also be considered to be merely arrangements of data, which is again non-statutory.

Claim 56 is rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Claim 56 is directed toward a method for determining a computer box identifier. The claim is directed to a judicial exception; as such, pursuant to the Interim Guidelines on Patent Eligible Subject Matter (MPEP 2106), the claims must have either physical transformation and/or a useful, concrete and tangible result. The claims fail to include transformation from one physical state to another. Although, the claims appear useful and concrete, there does not appear to be a tangible result claimed. Merely obtaining and combining would not appear to be sufficient to constitute a tangible result, since the outcome of the obtaining and combining step has not been used in a disclosed practical application nor made available in such a manner that its usefulness in a disclosed practical application can be realized. As such, the subject matter of the claims is not patent eligible.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-2, 4-14, 19, 21-26, 29-32, 37-48, 53, and 55-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Cronce (US 2003/0156719 A1).

As to claims 1, 19 and 42, Cronce discloses a system and method for delivery of a secure software license for a software product, the system and method having:

a user requesting activation of an inactive feature originally present in the software package (0035, lines 1-3)**;**

the user computer transmits a request for a feature activation license to a remote server of a software vendor (0035, lines 1-3)**;**

the remote server receives the request (0035, lines 1-3)**;**

the remote server processes the request (0035, lines 7-9)**;**

the remote server sends the feature activation license to the user computer (0011, lines 19-22)**;**

the user computer receives the feature activation license (0011, lines 19-22);

the user computer activates the inactive feature (0011, lines 19-22).

As to claim 2, Cronce discloses:

sending a request for activation of the inactive feature from a user computer to the remote server before the feature activation license is received by the remote server (0030, lines 7-12).

As to claim 4, Cronce discloses:

wherein the inactive feature is activated (i.e. full features) **automatically in response to a particular event** (0037, lines 6-7).

As to claim 5, Cronce discloses:

wherein the particular event is an expiration date (i.e. demo period) (0037, lines 8-9).

As to claim 6, Cronce discloses:

wherein the particular event is activation of another related inactive feature (i.e. full features) (0037, lines 6-7).

As to claims 7, 21 and 43, Cronce discloses:

wherein the feature activation license is authenticated (i.e. validates) **before the inactive feature is activated** (0040, lines 1-4).

As to claims 8, 22 and 44, Cronce discloses:

wherein currency is exchanged from a user of the software package to the software vendor in exchange for the feature activation license (0035, lines 1-3).

As to claims 9 and 24, Cronce discloses:

wherein the inactive feature is activated for a set period of time (0037, lines 11-14).

As to claims 10 and 25, Cronce discloses:

wherein a plurality of inactive features are activated (i.e. fully enabled) **concurrently** (0037, lines 11-14).

As to claims 11 and 29, Cronce discloses:

wherein the feature activation license (i.e. license response) **is encrypted** (0036, lines 8-10).

As to claims 12 and 30, Cronce discloses:

wherein the feature activation license is encrypted via a shared symmetric key (0036, lines 8-10). The examiner asserts that it is well known to use a shared symmetric key because it is another method of encryption that can be used.

As to claims 13 and 31, Cronce discloses:

wherein the feature activation license is encrypted via an asymmetric private key (0036, lines 8-10).

As to claims 14 and 32, Cronce discloses:

wherein the feature activation license is verified via a plurality of digital certificates (0041, lines 1-4; 0042, lines 1-6).

As to claim 23, Cronce discloses:

wherein the inactive feature is activated on a single computer (0040, lines 9-11).

As to claim 26, Cronce discloses:

wherein the inactive feature is activated for a specific device (0040, lines 9-11).

As to claim 37, Cronce discloses:

wherein the feature activation license is obtained electronically (0035, lines 9-11).

As to claim 38, Cronce discloses:

wherein the feature activation license is obtained through email (0035, lines 9-11).

As to claim 39, Cronce discloses:

wherein the feature activation license is obtained through a through an Internet web interface (0064, lines 1-5).

As to claim 40, Cronce discloses:

wherein the feature activation license is obtained via FTP (0064, lines 1-5). The examiner asserts that it is well known to use FTP for file transfers through an Internet web interface because it is functionally equivalent to other methods of file transfers.

As to claim 41, Cronce discloses:

wherein the feature activation license is obtained via SCP (0064, lines 1-5). The examiner asserts that it is well known to use SCP for file transfers through an Internet web interface because it is functionally equivalent to other methods of file transfers.

As to claim 45, Cronce discloses:

wherein the feature activation license is obtained through a human interaction (i.e. over the phone) (0035, lines 1-9).

As to claim 46, Cronce discloses:

a system information interface (0065, lines 1-3)**;**

a device information segment on the system information interface wherein the device information segment shows a product identification and a box identification (0062, lines 1-3, 6-9, 13-15)**;**

a software list segment on the system information interface wherein the software list segment shows a plurality of installed software packages (0040, lines 6-9)**;**

a feature activation list segment on the system information interface wherein the feature activation list shows a status of installed features related to an individual installed software package (0086, lines 5-13)**;**

a software upgrade/installation interface on the system information interface wherein the software upgrade/installation interface is utilized for selectively activating an inactive feature (0058, lines 12-16).

As to claim 47, Cronce discloses:

wherein the software list segment is further comprised of a name, a version, a description and an install date each of which is related to the individual software package (0086, lines 1-5).

As to claim 48, Cronce discloses:

wherein the feature activation list segment is further comprised of a description, an activation date, an expiration date and a status each of which is related to an individual installed feature of the individual installed software package (0098, lines 7-9).

As to claim 53, Cronce discloses:

a box identification corresponding to the user computer (0062, lines 6-9);

a box feature identification that has a list of features to be activated (0040, lines 6-9).

As to claim 55, Cronce discloses:

A software package which has inactive features that can only be activated through obtaining a feature activation license (0058, lines 4-5, 12-16).

As to claim 56, Cronce discloses:

obtaining a MAC identifier (0062, lines 6-9);

obtaining a system information component relating to the computer box (0062, lines 6-9);

combining the MAC identifier and the system information component into the computer box identifier (i.e. fingerprint) (0062, lines 9-11).

11. Claim 54 is rejected under 35 U.S.C. 102(e) as being anticipated by Moshir et al. (US 2002/0100036 A1 and Moshir hereinafter).

As to claim 54, Moshir discloses a system and method for non-invasive automatic offsite patch fingerprinting and updating, the system and method having:

a group identification corresponding to the user computer (0169, lines 1-2; 0170, lines 1-3);

a group feature identification that has a list of features to be activated (0174, lines 1-2).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 3, 15-18, 20, 33-36, and 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cronce as applied to claims 1, 19 and 46 above, and further in view of Chou et al. (US Patent 5,222,133 and Chou hereinafter).

As to claims 3 and 20, Cronce does not disclose:

wherein the inactive feature is not present in the software package and the inactive feature is bundled with the feature activation license.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Cronce, as evidenced by Chou.

Chou discloses a method for protecting computer software from unauthorized execution using multiple keys, the method having:

wherein the inactive feature (i.e. modifications) **is not present in the software package and the inactive feature is bundled with the feature activation license** (i.e. algorithm) **(col. 6, lines 49-56).**

Given the teaching of Chou, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Cronce with the teachings of Chou by providing for a software feature that is included with a license. Chou recites motivation by disclosing that protection is needed for a subsequently issued modification to a protected software package (col. 3,

lines 47-49). It is obvious that the teachings of Chou would have improved the teachings of Cronce by providing for an additional feature included with a license in order to provide protection for features not included in an original package.

As to claims 15 and 33, Cronce does not disclose:

> **adding a new feature to the software package wherein the new feature is encapsulated with the feature activation license.**

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Cronce, as evidenced by Chou.

Chou discloses:

> **adding a new feature** (i.e. modification) **to the software package wherein the new feature is encapsulated with the feature activation license** (col. 6, lines 49-56)**.**

Given the teaching of Chou, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Cronce with the teachings of Chou by adding a feature that is together with a license. Please refer to the motivation recited in respect to claims 3 and 20 as to why it is obvious to apply the teachings of Chou to the teachings of Cronce.

As to claims 16 and 34, Cronce discloses:

wherein a user of the software package is given an option of obtaining the new feature after requesting the feature activation license (0035, lines 1-6).

As to claims 17 and 35, Cronce does not disclose:

adding a patch to the software package wherein the patch is encapsulated with the feature activation license.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Cronce, as evidenced by Chou.

Chou discloses:

adding a patch (i.e. modification) **to the software package wherein the patch is encapsulated with the feature activation license** (col. 6, lines 49-56).

Given the teaching of Chou, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Cronce with the teachings of Chou by adding a feature (i.e. patch) that is together with a license. Please refer to the motivation recited in respect to claims 3 and 20 as to why it is obvious to apply the teachings of Chou to the teachings of Cronce.

As to claims 18 and 36, Cronce discloses:

wherein a user of the software package is given an option of obtaining the patch after requesting the feature activation license (0035, lines 1-6)**.**

As to claim 49, Cronce does not disclose:

wherein a feature activation license is obtained via the software upgrade/installation interface.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Cronce, as evidenced by Chou.

Chou discloses:

wherein a feature activation license is obtained via the software upgrade/installation interface (col. 6, lines 49-56)**.**

Given the teaching of Chou, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Cronce with the teachings of Chou by obtaining a license through a software upgrade in order to protect the additional features in the upgrade. Please refer to the motivation recited in respect to claims 3 and 20 as to why it is obvious to apply the teachings of Chou to the teachings of Cronce.

As to claim 50, Cronce discloses:

wherein the feature activation license is obtained through a through an Internet web interface (0064, lines 1-5)**.**

As to claim 51, Cronce discloses:

wherein the feature activation license is obtained via FTP (0064, lines 1-5). The examiner asserts that it is well known to use FTP for file transfers through an Internet web interface and is functionally equivalent to other methods of file transfers.

As to claim 52, Cronce discloses:

wherein the feature activation license is obtained via SCP (0064, lines 1-5). The examiner asserts that it is well known to use SCP for file transfers through an Internet web interface and is functionally equivalent to other methods of file transfers.

15. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cronce as applied to claim 19 above, and further in view of Moshir.

As to claim 27, Cronce does not disclose:

wherein a feature is activated on a plurality of devices.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Cronce, as evidenced by Moshir.

Moshir discloses:

wherein a feature is activated on a plurality of devices (0167, lines 1-3; 0168, lines 1-3).

Given the teaching of Moshir, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying

the teachings of Cronce with the teachings of Moshir by activating a feature of multiple devices. Moshir recites motivation by disclosing that updating software on multiple machines can be made easier by grouping machines according to function or location in order to make bandwidth utilization more efficient for the network (0167, lines 1-3; 0169, lines 1-3). It is obvious that the teachings of Moshir would have improved the teachings of Cronce by providing for the activation of a feature on multiple devices by using grouping in order to increase bandwidth efficiency.

As to claim 28, Cronce does not disclose:

wherein the feature is activated for the plurality of devices via a group identifier.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Cronce, as evidenced by Moshir.

Moshir discloses:

wherein the feature is activated for the plurality of devices via a group identifier (0168, lines 1-3; 0169, lines 1-2; 0170, lines 1-3; 0172, lines 1-2).

Given the teaching of Moshir, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Cronce with the teachings of Moshir by activating a feature on multiple devices using a group identifier. Please refer to the motivation recited above in respect

to claim 27 as to why it is obvious to apply the teachings of Moshir to the teachings of Cronce.

Prior Art Made of Record

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Begemann et al. (US 2003/0149579 A1) discloses a method of increasing functionality of a product.

b. Randall (US Patent 5,978,916) discloses a system and method for updating region-dependent software using a common update module for multiple regions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah Su whose telephone number is (571) 270-3835. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sarah Su/
Examiner, Art Unit 2131
/Ayaz R. Sheikh/

Supervisory Patent Examiner, Art Unit 2131